

## **REMARKS**

The Office Action mailed on June 18, 2010, has been reviewed and the comments of the Examiner carefully considered. Claim 1 has been amended herein. Claim 4 has been cancelled and the subject matter of claim 4 incorporated into claim 1 herein. No new matter has been added by way of these amendments. Claims 1-3 and 515 are pending and under consideration, and currently stand rejected.

### **Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 1-15 were rejected as allegedly indefinite. In particular, it is alleged that claim 1, from which claims 2-15 depend, is indefinite for not including a correlating step to accomplish the preamble of the claim. While not in agreement with the basis for the rejection, but rather, in an attempt to advance the prosecution of the application, Applicants have hereby amended claim 1 to include, at the end of the claim, the phrase "...thereby detecting the presence or absence of a microorganism of interest." Applicants respectfully submit that the claims are not indefinite and request reconsideration and withdrawal of the rejection.

### **Rejection under 35 U.S.C. § 102(b)**

Claims 1-3, 5, 6, 8, 9, 11, and 12-15 were rejected as allegedly being anticipated by Wolf et al. ((1996) J. Microb. Meth., 25:337-342). It is the Examiner's view that Wolf teaches claims 1-3, 5, 6, 8, 9, 11, and 12-15 in their entirety. Applicants respectfully traverse the Examiner's rejection for the following reasons.

It is well-settled that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and also MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil C. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ...claim". *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Therefore, WO99/52569 must describe each and every element of claims 11, 15-17 and 20 in order to anticipate these claims under section 102(b). However, Wolf does not meet this burden.

Claim 1 has been amended herein to more particularly encompass the claimed invention. In particular, claim 1 has been amended to recite that the microorganism is a “pathogenic” microorganism. Support for this amendment can be found throughout the specification, and, for example, in paragraphs [0011], [0139], [0144], [0156], and [0160] of the published application. The *Verticillium lecanii* of the Wolf reference is not pathogenic.

Furthermore, Applicants respectfully submit that the Examiner’s reference to the agar-containing growth medium in Wolf does not constitute a “resin” as the term is used in the present application, nor as the term is used in the art. In particular, with respect to claim 8, Applicants further note that the claim requires coupling of the claimed peptide to a solid support, which is also not disclosed by Wolf.

Accordingly, because Wolf does not teach each and every element of the claimed invention, Wolf therefore does not anticipate the claims. Applicants respectfully request reconsideration and withdrawal of the rejection.

#### **Rejections under 35 U.S.C. § 103(a)**

Claims 1, 4, 7, 8 and 10 were rejected as allegedly being obvious in view of the combination of the Wolf reference with PCT Publication WO03/063693. The Examiner notes that Wolf does not teach the substrates listed in claim 4, but contends that WO03/063693 teaches detection of SEQ ID NO:2. Applicants respectfully traverse both of the Examiner’s obviousness rejections for the following reasons.

The test which must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103 ...

[T]he four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations. (MPEP § 2141).

When applying 35 U.S.C. § 103, the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. MPEP § 2141 II. This test has not been satisfied here for the obviousness rejection, in view of the amended claims.

Applicants have cancelled claim 4 herein and incorporated the subject matter of claim 4 into claim 1. In doing so, Applicants have further amended claim 1 to remove reference to SEQ ID NO:2. Accordingly, as noted by the Examiner, because neither Wolf nor WO03/063693 teach the detection of any sequence other than SEQ ID NO:2, neither Wolf nor WO03/063693 provide any teaching or suggestion as how to arrive at the invention as set forth in the presently-amended claims. Consequently, because none of the rejected claims are obvious in view of the combination of WO03/063693 and Wolf, as set forth above, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a).

### **Double Patenting Rejection**

The provisional double patenting rejection over copending application 10/502,882 has been maintained in the office action. Because this rejection is still provisional, and because claims have not yet been allowed in either case, Applicants respectfully request that the rejection be held in abeyance until the claims in this case have been allowed, at which time the basis for the rejection may be re-assessed in view of any claim amendments in either patent application.

**Conclusion**

Applicants respectfully submit that the claims are in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5089 to clarify any unresolved issues raised by this response.

The Director is hereby authorized to charge the fee for the Petition for Extension of Time as well as charge/credit Deposit Account No. **50-0310** (Billing No. 101713-5089) for any other required fees, deficiencies or overpayments in connection with this Response.

Respectfully submitted,

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